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EXAMINER

SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,760

Applicant(s)

MICHAEL ET AL.

Examiner

James Sheleheda

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/22/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 42, 43 and 44 are objected to because of the following informalities:

In claims 42 and 43, line 1, "A computer program" should be changed to --A computer readable medium-- to maintain continuity with the previous claims language.

In claim 44, line 1, "A computer program" should be changed to --A method-- to maintain continuity with the previous claims language.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-12, 14, 15, 17-20, 22-30, 32, 33, 35-38 and 40-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Remillard (5,461,667) (of record).

As to claim 1, Remillard discloses a communication system for a digital television system (Fig. 1) including:

an interactive response system (20) in communication with a television system (50, Fig. 1) being arranged to accept an input from a user (user input to select a feature;

Fig. 3; column 6, lines 29-42) in response to an output signal produced by the television (Fig. 3; column 6, lines 7-13 and 29-34),

the interactive response system then being operative to trigger a communication between the user and a remote third party (Figs. 1 and 4; column 7, lines 12-14 and lines 35-48),

wherein the communication is dependent upon the output signal produced by the television (column 6, lines 29-34 and column 7, lines 2-17).

As to claim 2, Remillard discloses wherein the interactive response system is a set top box (see Figs. 1 and 2; column 5, lines 27-44).

As to claim 3, Remillard discloses wherein the interactive response system comprises at least a portion of a set top box operating system (Figs. 1 and 2; column 5, lines 45-56).

As to claim 4, Remillard discloses wherein the interactive response system is downloaded into the set top box upon first use of the input by a user (column 5, lines 44-56); and

wherein the output signal is produced by a remote control (52) to the set top box (column 6, lines 29-42) and from the set top box to a headend (Fig. 1; column 6, lines 29-42 and column 7, lines 35-48).

As to claim 5, Remillard discloses a processing system (30) in communication with the interactive response system (Fig. 1; column 4, lines 36-54), wherein the interactive response system triggers a communication by communicating details of the output signal to the processing system (column 7, lines 24-28), the processing system being arranged to determine the communication to be triggered in dependence on the output signal and to initiate the communication (Fig. 1; column 9, lines 4-12).

As to claim 6, Remillard discloses wherein the processing system is arranged to determine the mode of communication in dependence on the output signal (column 9, lines 4-11).

As to claim 7, Remillard discloses wherein the processing system is arranged to determine the content of the communication in dependence on the output signal (column 9, lines 4-11).

As to claim 8, Remillard discloses wherein the interactive response system communicates with the processing system via a communication network (Fig. 1).

As to claim 9, Remillard discloses wherein the communication network is one of a public service telephone network and a cellular network (column 4, lines 41-45).

As to claim 10, Remillard discloses wherein the communication network is a cable network (column 4, lines 42-45).

As to claim 11, Remillard discloses wherein the processing system is in a location remote to the user (Fig. 1) and is arranged to server a plurality of users (column 4, lines 36-55).

As to claim 12, Remillard discloses the output signal represents an email (Fig. 3; column 6, lines 43-64).

As to claim 14, Remillard discloses wherein the remote third party is a telephone associated with the sender of the output signal (column 9, lines 4-15), and wherein the interactive response system is operative to trigger a telephone call between a telephone associated with the user and the telephone associated with the sender of the output signal (column 9, lines 4-15).

As to claim 15, Remillard discloses wherein the remote third party is a voicemail system associated with a sender of the output signal (column 9, lines 4-15), and wherein the interactive response system is operative to trigger a telephone call between a telephone associated with the user and the voicemail system (Fig. 6B; column 9, lines 4-15).

As to claim 17, Remillard discloses wherein the output signal represents an information page (Fig. 3).

As to claim 18, Remillard discloses wherein the interactive response system is operative to trigger a telephone call between a telephone associated with the user and the telephone associated with the sender of the output signal (column 9, lines 4-15).

As to claim 19, Remillard discloses wherein the interactive response system is operative to transmit a request to the remote third party (column 9, lines 28-51), the request comprising information on a content of the output signal and information on the user (column 9, lines 28-53), wherein the remote third party uses the information to communicate with the user about the content (column 9, lines 28-53 and column 6, lines 58-64).

As to claim 20, Remillard discloses wherein the request is communicated electronically to a computer system associated with the output signal (column 9, lines 28-53).

As to claim 22, Remillard discloses wherein the remote third party communicates with the user via email (column 6, lines 58-64).

As to claim 23, Remillard discloses an interactive response method for a digital television system (Fig. 1) comprising:

accepting an input from a user in response to an output signal produced by a television of the digital television system (user input to select a displayed feature; Fig. 3; column 6, lines 29-42); and

triggering a communication between the user and a remote third party (Figs. 1 and 4; column 7, lines 12-14 and lines 35-48), wherein the communication is dependent upon the output signal produced by the television (column 6, lines 29-34 and column 7, lines 2-17).

As to claim 24, Remillard discloses wherein the step of accepting comprises receiving the input at a set top box arranged to communicate with the digital television system (see Figs. 1 and 2; column 5, lines 27-44 and column 6, lines 29-42).

As to claim 25, Remillard discloses communicating details of the output signal from the set top box to a processing system (Fig. 1; column 4, lines 36-54 and column 7, lines 24-28);

determining at the processing system the communication to be triggered in dependence on the output signal (Fig. 1; column 9, lines 4-12); and

initiating the communication (Fig. 1; column 9, lines 4-12).

As to claim 26, Remillard discloses determining a type of communication in dependence on the output signal (column 9, lines 4-11).

As to claim 27, Remillard discloses determining content of the communication in dependence on the output signal (column 9, lines 4-11).

As to claim 28, Remillard discloses communicating via one of a communication network (Fig. 1), a public service telephone network (column 4, lines 41-45) and a cable network (column 4, lines 42-45).

As to claim 29, Remillard discloses downloading computer program code corresponding to the interactive response method into the set top box upon first use of the input by a user (column 5, lines 44-56).

As to claim 30, Remillard discloses wherein the output signal represents an email (Fig. 3; column 6, lines 43-64).

As to claim 32, Remillard discloses triggering a telephone call between a telephone associated with the user and the telephone associated with the sender of the output signal (column 9, lines 4-15).

As to claim 33, Remillard discloses triggering a telephone call between a telephone associated with the user and a voicemail system (Fig. 6B; column 9, lines 4-15).

As to claim 35, Remillard discloses wherein the output signal represents an information page (Fig. 3).

As to claim 36, Remillard discloses triggering a telephone call between a telephone associated with the user and a telephone system associated with the sender of the output signal (column 9, lines 4-15).

As to claim 37, Remillard discloses generating a request (column 9, lines 28-51), the request comprising information on a content of the output signal and information on the user (column 9, lines 28-53), and transmitting the request to the remote third party (column 9, lines 28-51), wherein the remote third party uses the information to communicate with the user about the content (column 9, lines 28-53 and column 6, lines 58-64).

As to claim 38, Remillard discloses communicating the request electronically to a computer system associated with the output signal (column 9, lines 28-53).

As to claim 40, Remillard discloses wherein the remote third party communicates with the user via email (column 6, lines 58-64).

As to claim 41, Remillard discloses a computer readable medium (Fig. 2) on which is stored a computer program of instructions (column 5, lines 28-55) for a general purpose computer for an interactive system for a digital television system (Fig. 1) comprising, in combination:

means for enabling the computer to accept an input from a user (IR detector, 132; column 6, lines 24-29) in response to an output signal produced by a television of the digital television system (user input to select a displayed feature; Fig. 3; column 6, lines 29-42); and

means for enabling the computer to trigger (CPU, 100) a communication between the user and a remote third party (Figs. 1 and 4; column 7, lines 12-14 and lines 25-48), wherein the communication is dependent upon the output signal produced by the television (column 6, lines 29-34 and column 7, lines 2-17).

As to claim 42, Remillard discloses wherein the means for enabling the computer to trigger a communication comprises:

means for enabling the computer to communicate details of the output signal to a processing system (Fig. 1; column 4, lines 36-54 and column 7, lines 24-28);

means for enabling the processing system to determine the communication to be triggered in dependence on the signal (column 9, lines 4-12); and

means for enabling the processing system to instigate the communication
(column 9, lines 4-12).

As to claim 43, Remillard discloses means for enabling the computer to
download a remainder of the computer program upon first use of the input by a user
(column 5, lines 57-63 and column 8, lines 35-37).

As to claim 44, Remillard discloses wherein the output signal represents an email
(Fig. 3; column 6, lines 43-64).

As to claim 45, Remillard discloses a program storage device readable by a
machine and encoding a program of instructions for executing the method steps of
claim 23 (column 5, lines 28-56).

As to claim 46, Remillard discloses a computer system adapted to provide an
interactive response system (Fig. 2) comprising:

a processor (CPU, 100), and
a memory (100 and 102) including software instructions adapted to enable the
computer system to perform operations (column 5, lines 28-56) comprising:

accepting an input from a user in response to an output signal produced by a
television of the digital television system (user input to select a displayed feature; Fig. 3;
column 6, lines 29-42); and

triggering a communication between the user and a remote third party (Figs. 1 and 4; column 7, lines 12-14 and lines 35-48), wherein the communication is dependent upon the output signal produced by the television (column 6, lines 29-34 and column 7, lines 2-17).

As to claim 47, Remillard discloses a computer program product for enabling a computer to provide an interactive response system for a digital television system comprising software instructions for enabling the computer to perform predetermined operations (column 5, lines 28-56), and a computer readable medium bearing the software instructions (Fig. 2), the predetermined instructions including:

accepting an input from a user in response to an output signal produced by a television of the digital television system (user input to select a displayed feature; Fig. 3; column 6, lines 29-42); and

triggering a communication between the user and a remote third party (Figs. 1 and 4; column 7, lines 12-14 and lines 35-48), wherein the communication is dependent upon the output signal produced by the television (column 6, lines 29-34 and column 7, lines 2-17).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Remillard as applied to claims 12 and 30 and further in view of Dugan et al. (Dugan) (6,330,079).

As to claims 13 and 31, while Remillard discloses wherein the remote third party is a voice recording system arranged to record a voice message as an electronic file (column 9, lines 4-11), wherein the interactive response system is operative to trigger a telephone call between a telephone associated with the user and a third party (column 9, lines 4-11), the communication system being arranged to transmit the communication to the sender of the output signal (column 9, lines 4-26) and email messages (column 6, lines 29-64), he fails to specifically disclose triggering a call from the user to record an electronic file and transmitting the electronic file as an attachment to an email.

In an analogous art, Dugan discloses multi-format transmission platform (column 3, line 63-column 4, line 19) which includes speech to text software (column 16, lines 41-56) to allow the conversion of voice messages to any other format (including email; column 16, lines 41-56) and transmitting the email message (column 16, lines 41-56) for the typical benefit of allowing messages to be converted into any format the subscriber desires (column 16, lines 53-56).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Remillard's system to include triggering a call from the user to record an electronic file and transmitting the electronic file as an attachment to

an email, as taught by Dugan, for the typical benefit of allowing messages to be converted into any format the subscriber desires.

6. Claims 16 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Remillard as applied to claims 1 and 23 above, and further in view of Merwin et al. (Merwin) (6,731,725).

As to claims 16 and 34, while Remillard discloses a voice recording system arranged to record voice messages as electronic files (column 9, lines 6-20), the interactive response system being operative to trigger a telephone call between a telephone associated with the user and the voice recording system (column 9, lines 6-20), he fails to specifically wherein the output signal represents a future date and/or time, recording a voice message as an electronic file, the communication system associating the electronic file with the future date and/or time and being arranged to call a telephone associated with the user on the date and/or time and play the electronic file to the user.

In an analogous art, Merwin discloses a communication system (Fig. 1) wherein a user will call a voice recording system (column 5, lines 29-31) to record a voice message as an electronic file (column 5, lines 56-60) and wherein the user will specify a future date and time for the electronic file to be output (column 5, lines 48-52) to enable the system to call the user on the specified date and time (column 5, line 63-column 6, line 2) and play the electronic file to the user (column 6, lines 3-9) for the typical benefit

of allowing users to automatically provide future reminder messages to themselves (column 3, line 50-column 4, lines 13).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Remillard's system to include wherein the output signal represents a future date and/or time, recording a voice message as an electronic file, the communication system associating the electronic file with the future date and/or time and being arranged to call a telephone associated with the user on the date and/or time and play the electronic file to the user, as taught by Merwin, for the typical benefit of allowing users to automatically provide future reminder messages to themselves.

7. Claims 21 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Remillard.

As to claims 21 and 39, while Remillard discloses transmitting a request to a computer system associated with the output signal (column 9, lines 28-51) and the use of email (column 6, lines 29-64), he fails to specifically disclose wherein the request is an email.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to modify Remillard's system to transmit requests utilizing the ubiquitous email format, such as when requesting additional information concerning an item or to order a product or service, for the typical benefits of taking advantage of a widely accepted and utilized communication format to allow a user to make a request.

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It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Remillard's system to include wherein the request is an email for the typical benefits of taking advantage of a widely accepted and utilized communication format to allow a user to make a request.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gainey et al. (US 2002/0099681) disclosing an email system for transmitting email questions and requests between consumers and corporations.

Sartain et al. (5,914,712) disclosing a television distribution system wherein subscriber responses and requests are transmitted through Internet e-mail.

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2617

JS



VIVEK SRIVASTAVA
PRIMARY EXAMINER